



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,949	04/22/2002	Edward Yan Tao Leung	P-370.226	1691
7590	02/07/2006		EXAMINER	
Thomas E Sisson Jackson Walker Suite 2100 112 E Pecan Street San Antonio, TX 78205			RAMPURIA, SHARAD K	
			ART UNIT	PAPER NUMBER
			2688	
DATE MAILED: 02/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/980,949	LEUNG ET AL.	
	Examiner	Art Unit	
	Sharad Rampuria	2688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5 and 8-12 is/are allowed.
- 6) ☒ Claim(s) 7 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

I. The current office-action is in response to the amendment filed on 11/21/05.

Accordingly, Claims 1 & 6 are cancelled, 2-5 & 8-12 are previously allowed, and Claims 7, 13-16 are pending for further examination as follows:

Claim Rejections - 35 USC § 103

II. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

III. Claims 7, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Molne [US 5999811] in view of Seppanen et al. [US 5903832].

Regarding claims 7, 13-14, Molne disclose A Subscriber Identity Module (41; Fig.2) for a mobile telephone (32; Fig.2) arranged to automatically establish a roaming service with a public land mobile network, the telephone including a subscriber identity module having an operator list of preferred public land mobile networks and network selection data wherein prior to a location update the preferred public land mobile networks contained in the PLMN selector data have preference over other user-defined or operator-defined public land mobile networks. (Col.3; 33-55 & Col.4; 16-35, Col.5; 4-12 & 25-40, Col.7; 65-Col.8; 13 and Claim 1)

Molne fails to disclose the network selection data is modified to include the preferred public land mobile networks from the operator list. However, Seppanen teaches in an analogous art, that the network selection data is modified to include the preferred public land mobile networks from the operator list. (Col.7; 10-24) Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the network selection data is modified to include the preferred public land mobile networks from the operator list in order to provide a capability of enhanced system selection.

Regarding claim 15, Molne disclose A mobile telephone according to claim 14 wherein the network selection data includes a registered public land mobile network and a country code of the registered public land mobile network is compared with preferred public land mobile networks from the operator list, the most preferred network with the same country code replacing the registered public land mobile network. (Col.7; 65-Col.8; 13)

Art Unit: 2688

IV. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Molne & Seppanen further in view of Lee et al. [US 5974328] (hereinafter Lee).

Regarding claim 16, the above combination discloses all the particulars of the claim except the network selection data includes a public land mobile network (PLMN) selector and preferred public land mobile networks from the operator list are copied to the PLMN Selector. However, Lee teaches in an analogous art, that a mobile telephone according to claim 14 wherein the network selection data includes a public land mobile network (PLMN) selector and preferred public land mobile networks from the operator list are copied to the PLMN Selector. (Col.4; 18-33 & Col.2; 29-34, Col.3; 6-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to include the network selection data includes a public land mobile network (PLMN) selector and preferred public land mobile networks from the operator list are copied to the PLMN Selector in order to provide rapid system access of mobile phones outside of its home service area.

Allowable Subject Matter

V. The following is an examiner's statement of reasons for allowance:

All of the above prior art fails to disclose a method of automatically establishing a roaming service for a mobile telephone, including using a pre-programmed SIM card such that a Location Update is performed in the following **logical order**: - 1. Registered Public Land Mobile Network ("RPLMN") i.e. the last registered network as stored in the SIM directory (EF6F7E) 2. Home PLMN ("HPLMN") 3. PLMNs contained in a "IPLMN Selector" data field

Art Unit: 2688

based on the "Operator List". 4. User--defined preferred PLMN 5. Other PLMNs with received signal level above a predetermined strength in random order; and 6. All other PLMNs in order of descending signal strength.

Claims 2-5 & 8-12 are allowed based on over Molne & Seppanen further in view of Lee et al.

Response to Arguments

VI. ***Applicant's arguments filed on 11/21/2005 have been fully considered but they are not persuasive.***

In response to Applicant's argument that Molne doesn't teach, "the preferred public land mobile networks contained in the PLMN selector data have preference over other user-defined or operator-defined public land mobile networks." it is noted that Molne supports the assertion as, in the PLMN selection process, which is also hard coded into the PCS1900 mobile station like that of AMPS, the mobile station normally looks for cells only in its home PLMN. If no service is available on the home PLMN, then the mobile station will search for a preferred PLMN whose identities are stored at SIM memory location 6F30. If the mobile station locks onto a preferred PLMN, the user can alternatively select another network by commanding the mobile station to make a new network search, assuming that there is a second network covering the geographic area in which the mobile station is currently located which is not identified as a forbidden PLMN at SIM memory location 6F7B. These forbidden PLMNs may be identified by the subscriber's network operator so that the mobile station will not access these other

Art Unit: 2688

networks. (Col.4; 16-35, Col.5; 25-40, Col.7; 65-Col.8; 13 and Claim 1) Hence, it is believed that Molne teaches the claimed limitations.

Also, Applicant's argument that Seppanen doesn't teach, "the network selection data is modified to include the preferred public land mobile networks from the operator list. " it is noted that Seppanen supports the assertion as, In the automatic mode the mobile station 10 automatically selects one of the available systems. If coverage is lost, the automatic selection procedure is restarted without requiring any user action. A system is selected primarily using the priorities defined as to the different network types. If there are several systems with the same priority available, then one of the received signal according to the received signal strength. That is, the system having the highest received signal strength is selected. The priority order of the different network types as default are as follows (highest priority first): residential systems; private systems; and public systems. The priority order of the different public systems depends on the PUBLIC NETWORKS menu selection, as described below with regard to FIGS. 19A through 19F. (Col.7; 10-24)."

For that reason, it is believed and as enlighten above, the rejections should be sustained.

Conclusion

VII. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 2688


MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharad Rampuria whose telephone number is (571) 272-7870. The examiner can normally be reached on M-F. (8:30-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or EBC@uspto.gov.

Sharad Rampuria
Examiner
Art Unit 2688


GEORGE ENG
SUPERVISORY PATENT EXAMINER